THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOHN R. FOGLE

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Appeal No. 98-0377
Application 08/573,460[1]

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ON BRIEF

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Before McQUADE, NASE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John R. Fogle appeals from the final rejection of claims 1 through 17, all of the claims pending in the application.

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[1] Application filed December 15, 1995 for the reissue of U.S. Patent No. 5,463,815, granted November 7, 1995, based on Application 08/304,155, filed September 12, 1994.

We reverse and remand the application for further consideration.

The invention relates to a flexible cutting line for use in a weed and grass trimmer. A copy of the appealed claims appears in the appendix to the appellant's brief (Paper No. 21).

Claims 1 through 17 stand rejected under 35 U.S.C. § 251 on the basis of the examiner's determination that "error 'without any deceptive intention' has not been established" (answer, Paper No. 22, page 2).[2]

Before discussing this rejection, we note that the appellant has raised as an issue on appeal (see page 9 in the brief) the propriety of the examiner's refusal to enter the amendment (Paper No. 7) filed subsequent to the final

[2] The examiner entered this rejection in a final rejection dated July 1, 1998 (Paper No. 15) in response to a remand from this Board (see Paper No. 14) for reconsideration of the application in light of the amendments made to 37 CFR § 1.175 effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997).

rejection dated November 8, 1996 (Paper No. 6).[3] It is well settled that the refusal of an examiner to enter such an amendment is a matter of discretion which is reviewable by petition to the Commissioner rather than by appeal to this Board. In re Mindick, 371 F.d. 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we shall not further discuss this matter.

Turning now to the merits of the examiner's rejection, the record includes two reissue declarations (an original and a supplemental) which indicate that:

a) the patentee (the appellant) filed the instant application for the reissue of U.S. Patent No. 5,463,815 on the belief that the patent was partly inoperative or invalid "because independent Claims 1 and 17 claim more than patentee had a right to claim in the patent by failing to include the limitations presented originally in dependent claim 10" (original reissue declaration, page 4);

b) the patentee came to this belief upon becoming aware,

[3] The examiner effectively withdrew the finality of this particular rejection by issuing the final rejection dated July 1, 1998 (see note 2, supra). It is the latter rejection from which the current appeal is taken.

subsequent to the payment of the issue fee on May 13, 1995 and a short time prior to the issuance of the patent on November 7, 1995, of a flexible cutting line distributed by Arnold Corporation under the trademark “MAXIEDGE” (see the original reissue declaration at page 4);

c) the patentee became aware of the dimensional characteristics of the “MAXIEDGE” line on September 4, 1995 (see the supplemental reissue declaration at page 1);

d) the patentee, determining that the limitations in dependent patent claim 10 were not encompassed by the “MAXIEDGE” line, presented claims 1 and 17 in the reissue application “amended to substantially incorporate the subject matter of original dependent Claim 10" (original reissue declaration, page 5); and

e) the patentee chose to correct the errors forthwith by way of reissue because issuance of the patent was considered to be imminent (see the supplemental reissue declaration and page 5 in the original reissue declaration);

In addition, the original reissue declaration includes plural statements by the patentee that the errors in question

arose without any deceptive intent or intention (see pages 3, 4 and 5).

Notwithstanding the appellant's express disavowal of any deceptive intention, the examiner entered and maintained the § 251 rejection on appeal because

> Appellant [had] sufficient time (i.e. **two months**) to correct the error by either submitting [an] Information Disclosure Statement, Amendment under 37 CFR § 1.312(b) or by petition to [withdraw] the application from issue. However, Appellant chose not to do so, instead, he intentionally permitted the letters patent to issue with a known defect. Therefore, no "error without deceptive intent", a condition precedent to reissue, has been established [answer, page 5].

The examiner's position here is unsound for at least two reasons.

To begin with, in rejecting a claim an examiner bears the initial burden of presenting a factual basis establishing a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1990); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Thus, with regard to the rejection on appeal the examiner had the initial burden of presenting a factual basis establishing a prima facie case that the errors at issue did not arise without any deceptive intention. The facts relied

upon by the examiner to meet this burden, i.e., that the appellant chose to correct the errors via the instant reissue application rather than by attempting to amend the application before it matured into the patent, are not, in and of themselves, indicative of any deceptive intention.

Moreover, under the current PTO practice an applicant for reissue is not required to "establish" that the errors sought to be corrected by reissue arose without any deceptive intention. In this regard, an applicant's statement in the reissue oath or declaration of a lack of any deceptive intention is to be accepted as being dispositive in the absence of special circumstances such as an admission or a judicial determination to the contrary (see MPEP §§ 1448 and 2012; and also MPEP §§ 1414 and 2022.05). The record does not reflect the presence of any such special circumstances in this case.

Accordingly, we shall not sustain the standing 35 U.S.C. § 251 rejection of claims 1 through 17.

Finally, we remand the application to the examiner to consider whether the subject matter currently set forth in independent claims 1 and 17, and in claims 2 through 16 which

depend from claim 1, raises issues with respect to the written description requirement of 35 U.S.C. § 112, first paragraph, and/or the new matter prohibition of 35 U.S.C. § 251. More particularly, the recitation in claims 1 and 17 that the main body portion of the flexible cutting element is located relative to a straight line extending from one cutting edge to an adjacent cutting edge a distance which does not extend inwardly "more than 10 percent" of the length of the straight line does not appear to have original support in the appellant's disclosure. In this regard, claim 10, from whence this limitation allegedly came, actually recites that the straight line extends from one cutting edge to an adjacent cutting edge a distance which is "less than 10 percent" of the length of the straight line.

In summary:

a) the decision of the examiner to reject claims 1 through 17 under 35 U.S.C. § 251 is reversed; and

b) the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED

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| JOHN P. McQUADE<br>Administrative Patent Judge | ) | |
| JEFFREY V. NASE<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| JOHN F. GONZALES<br>Administrative Patent Judge | ) | |

Appeal No. 98-0377
Application 08/573,460

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